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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

NOTIFICATION DATE	DELIVERY MODE
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06/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

DETAILED ACTION

ADVISORY ACTION

1. The proposed amendments filed on May 20, 2009 have been fully considered but will not be entered because: (1) they raise new issues that would require further consideration and/or search; and (2) they raise the issue of new matter.

Response to Arguments

I. In page 12, first paragraph of applicant's remarks, applicant argues that "[A]pplicants have amended claims 1, 11, 13 and 20 as suggested by the Examiner. As such, withdrawal of the objection is respectfully requested".

After carefully considered applicant's argument and the proposed amendments, the examiner agrees to withdraw the objections on claims 1, 10, 11, 13, and 20 if the amendments have been entered.

II. In page 7, second paragraph bridging to page 15, last paragraph of applicant's remarks, applicant argues that all rejections under 35 U.S.C 112, first and second paragraphs have been overcome in view of the proposed amendments.

The argument has been fully considered but it is not persuasive toward the withdraw of the rejections because applicant's arguments with respect to claims 1-15, 19-23, and 34-42 are moot since applicant has amended independent claims 1 and 11. The proposed amendments in claims 1 and 11 raise new issues that would require further consideration and/or search and raise the issue of new matter. For example, claims 1 and 11 is vague and indefinite because, although claims 1 and 11 require that a solid phase-holding member connects to the leading end part of a cylindrical syringe, since the claim does not require that the solid phase-holding member is

Art Unit: 1634

inside of the cylindrical syringe, if the solid phase-holding member is outside of the cylindrical syringe and connects to the leading end part of a cylindrical syringe, it is unclear how the solid phase, which is accommodated in said solid phase-holding member, can locate only at the first opening part. Furthermore, although the specification describes an apparatus for separating and purifying nucleic acids comprising (a) a solid phase, (b) a container having at least two openings for accommodating said solid phase, (c) a pressure difference generating apparatus coupled to one of the openings of said container and (d) a pressure sensor (e.g., see original filed claim 34), the specification fail to define or provide any disclosure to support the phrase “the pressure difference-generating apparatus which couples to one of the first and second opening parts” recited in claims 1 and 11 since one of the first and second opening parts is different from one of the first and second openings (see Figure 1 of the specification). Thus proposed amendments in claims 1 and 11 raise the issue of new matter.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz, can be reached on (571)272-0763.

Art Unit: 1634

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/Frank W Lu /
Primary Examiner, Art Unit 1634
June 1, 2009